

REMARKS

I. Introduction

Claims 17-33 are pending in the present application. Claims 26-30 and 32-33 have been withdrawn from consideration. Claims 17-21 have been amended. In view of the foregoing amendments and following remarks, it is respectfully submitted that claims 17-25 and 31 under consideration are allowable, and reconsideration is respectfully requested.

II. Rejection of Claims 17-25 under 35 U.S.C. § 112, Second Paragraph

Claims 17-25 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because it is allegedly not clear whether the phrase “partial functionalities” refer to computer program instructions. Applicants respectfully submit that there is no ambiguity regarding the phrase “partial functionalities” since this phrase is clearly defined in the substitute specification, e.g., p. 3, l. 26 – p. 4, l. 24, and p. 5, l. 9 – p. 6, l. 24. As clearly indicated on p. 3, l. 26-32, “vehicle-related telematics service” refers to an operation “in which information is exchanged between a vehicle (the vehicle data terminal) and a server, . . . in connection with functions for remote action, remote diagnosis, remote service, software download etc.” It is further indicated on p. 4, l. 22-24 that “[t]hese functionalities as a whole are subsumed here under the term of vehicle-related telematics service.” Accordingly, the phrase “partial functionalities” encompasses more than merely computer program instructions. While Applicants do not believe any ambiguity is presented by the phrase “partial functionalities,” Applicants have amended claims 17-19 to recite, in relevant parts, “subdividing the telematics service into partial telematics functionalities that are critical with respect to time and partial telematics functionalities that are not critical with respect to time,” thereby clearly indicating that the “partial functionalities” relate to the overall telematics service and encompass more than merely computer program instructions. Claims 20 and 21 have been similarly amended to recite “partial telematics functionalities.”

For the foregoing reasons, it is respectfully submitted that amended claims 17-21, as well as claims 22-25 which ultimately depend on claim 17, are in compliance with 35 U.S.C. § 112, second paragraph.

III. Rejection of Claims 17-25 and 31 under 35 U.S.C. § 102(a)

Claims 17-25 and 31 were rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent App. Pub. No. 2002/0044049 ("Saito"). It is respectfully submitted that claims 17-25 and 31 are not anticipated by Saito for at least the following reasons.

To anticipate a claim under § 102(a), a single prior art reference must identically disclose each and every claim element. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Additionally, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Independent claims 17-19 recite, in relevant parts, "subdividing the telematics service into partial telematics functionalities that are critical with respect to time and partial telematics functionalities that are not critical with respect to time." The Examiner simply does not address limitation, and there is no suggestion in Saito of performing the claimed subdivision of selected telematics functionalities based on whether the functionalities are critical with respect to time. For at least this reason, claims 17-19, as well as dependent claims 20-25, are allowable over Saito.

Independent of the above, independent claims 17 and 19 further recite "executing in the data terminal the partial telematics functionalities that are critical with respect to time." The Examiner does not even address this limitation, and there is no suggestion in Saito regarding anything even remotely relevant to the above-recited claimed feature. For at least this reason, claims 17 and 19, as well as dependent claims 20-25, are allowable over Saito.

Independent of the above, independent claims 17 and 18 further recite "executing in

the server the partial telematics functionalities that are not critical with respect to time.” The Examiner does not address this limitation, and there is no suggestion in Saito regarding specifically performing in the server telematics functionalities that are not critical with respect to time. For at least this reason, claims 17 and 18, as well as dependent claims 20-25, are allowable over Saito.

With respect to claim 31, Applicants note that claim 31 recites, in relevant parts, “activating a diagnosis mode in **a control unit** located in the vehicle; transmitting diagnosis commands from the **server** to the **control unit** via the **data terminal**; transmitting answers from the **control unit** to the **server** via the **data terminal**.” Accordingly, the claimed features involve communication among three separate elements: the server, the control unit and the data terminal. However, the Examiner simply fails to address the above-recited features regarding the interaction of the server, the control unit and the data terminal; instead, the Examiner merely discusses the alleged disclosure of Saito regarding the communication between “the mobile terminal (111) and the server (100) via the network (103).” More importantly, there is no suggestion in Saito regarding the above-recited claimed feature of claim 31, i.e., “activating a diagnosis mode in **a control unit** located in the vehicle; transmitting diagnosis commands from the **server** to the **control unit** via the **data terminal**; transmitting answers from the **control unit** to the **server** via the **data terminal**.” For at least this reason, claim 31 is allowable over Saito.

IV. CONCLUSION

In view of all of the above, it is respectfully submitted that all of the presently pending claims 17-25 and 31 under consideration are in allowable condition. Prompt reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,

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